

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

OCT 27 2006

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte VENKATESH KRISHNAN,  
JEAN TOURRIHES, and JEFFREY A. MORGAN

Application No. 09/770,556

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on October 17, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

A review of the application indicates that the following headings are missing from the Appeal Brief of September 26, 2005:

- 1) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related Proceedings Appendix," as set forth in 37 CFR § 41.37.

A supplemental brief that is in compliance with 37 CFR §41.37(c) is required.

The Examiner's Answer mailed December 1, 2005 is defective because in paragraph 8 it is stated, "no evidence is relied upon by the examiner." However, prior art was applied in the rejections on appeal. The Manual of Patent Examining Procedure, (MPEP), in § 1207.02 states:

(8) *Evidence Relied Upon*. A listing of the \*\*>evidence< relied on >(e.g., patents, publications, admitted prior art)<, and, in the case of nonpatent references, the relevant page or pages.

Appropriate correction is required.

An Information Disclosure Statement (IDS) was filed February 24, 2006. It is not apparent from the record that the examiner properly considered the IDS submitted nor notified appellants of why his submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief of September 26, 2005 incomplete;
- 2) for the applicant to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;
- 3) for the examiner to consider the supplemental Appeal Brief, and, if necessary, vacate the Examiner's Answer mailed November 28, 2005 and issue a revised Examiner's Answer;
- 4) to list the prior art being relied upon under the heading "Evidence Relied Upon" in paragraph 8 in the Examiner's Answer;
- 5) for the examiner to consider the February 24, 2006 IDS;

6) give written notification to appellants regarding the result of the examiner's consideration; and

7) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
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